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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,254	12/27/2000	Siamak Tabibzadeh	0152.00384	8450

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EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/674,254

Applicant(s)

TABIBZADEH, SIAMAK

Examiner

Ginny Portner

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 70.

Claim(s) objected to: _____.

Claim(s) rejected: 41-69 and 71-80.

Claim(s) withdrawn from consideration: 81-85.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Attachments of prior art

Continuation of 2. NOTE see attachment.

Continuation of 5. does NOT place the application in condition for allowance because: the amendments submitted were not entered and Applicant's remarks are directed to priority and claim limitations not entered.

Priority

1. The Amendment After Final submitted July 14, 2004 will not be entered because it does not comply with the rules for obtaining priority in a National Stage Application filed on or after November 29, 2000. The filing date of the instant Application being December 27, 2000.

If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). *A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional.* The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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1. While the PCT application WO99/55902 recited the following phrases:
“This application is a conversion of a United States Provisional Application filed April 29, 1998, Serial No. 60/083,418. Continuation in Part of application Serial No. 08/919,421 filed 8/27/97 which claims benefit of US Provisional Application No. 60/025,800 filed August 27, 1996.”
2. The only priority granted was to the United States Provisional Application filed April 29, 1998, Serial No. 60/083,418.
3. The Continuation in Part of application Serial No. 08/919,421 filed 8/27/97 which claims benefit of US Provisional Application No. 60/025,800 filed August 27, 1996 were not found to be a basis for priority in the PCT Application, as the filing dates for both US Applications were greater than one year prior to the filing date of PCT Application US99/09366.
4. Additionally, priority claimed through a Provisional Application 60/083,418 is not provided for, nor permitted. The claim for priority was set forth through a provisional Application by reciting the phrase:
5. “is a conversion of a United States Provisional Application filed April 29, 1998, Serial No. 60/083,418. Continuation in Part of application Serial No. 08/919,421 filed 8/27/9797 which claims benefit of US Provisional Application No. 60/025,800 filed August 27, 1996” which did not provide for attainment of priority back to the earliest recited Application . 60/025,800.
6. The submission of an Amendment of the first sentence of the Specification, July 14, 2004, After Final is considered not to be timely filed.

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7. Additionally, the Amendment After Final submits new claims directed to an embodiment not previously examined, and therefore not Finally rejected nor considered on the record, and therefore also raises a new issue After Final.

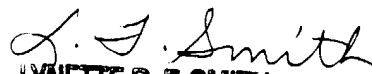
8. For the reasons recited above, the Amendment submitted After Final, dated July 14, 2004 has not been entered.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (571) 272-0862. The examiner can normally be reached on 7:30-5:00 M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vgp
September 15, 2004


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

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DETAILED ACTION

1. Claims 41-80 and new claims 81-85 are pending.
2. Claims 63, 72 and 73 have been amended.
3. Claim 70 is allowed
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

5. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.
6. The earliest priority claimed in the original first paragraph of the first page of the Specification, under the heading "CROSS-REFERENCE TO RELATED APPLICATION", was not granted by the PCT searching Authority, as shown on the front of the published PCT Application WO99/55902. The priority granted the PCT Application, PCT/US99/09366, was only to provisional Application 60/083,418 and not to any other US Applications or provisional Applications as asserted by Applicant.
7. The amendment of the first paragraph of the Instant Specification, submitted in October 20, 2000, did not cancel the priority claim not granted by the PCT searching authority.
8. The second paragraph page 1, reads:

"This application is a conversion of a United States Provisional Application filed April 29, 1998, Serial number 60/083,418. Continuation in Part of application Serial NO. 08/919,421 filed 8/27/97 which claims benefit of US Provisional Application No. 60/025,800 filed August 27, 1996."

The second sentence in this paragraph is an incomplete thought as a "." period occurs after the recitation of the number: 60/083,418. The second thought presented is discontinuous with the first. Even if this portion of the paragraph were amended, the priority would not be granted as the PCT searching authority did not grant priority to the earliest application recited. The content

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of the second sentence of this paragraph should be canceled as the Instant Specification has not and can not perfect the priority claimed as it was not granted by the PCT searching authority.

The instant Application was filed as a National Stage Application under 35 USC 371, not 37 CFR 1.111.

9. Prior acknowledgement of a claim to priority, not granted by the PCT searching authority is also not perfected or granted in the instant Application. The earliest priority date granted in the instant Application is to Provisional Application 60/083,418 filed April 29, 1998.

Election/Restrictions

10. Newly submitted claims 81-85 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the methods encompassed by new claims 81-85 recite a combination of claim limitations and components contained in compositions not previously considered on the record and are directed to methods that are independent and distinct based upon the difference of structure, function and biological effect of antibodies, antisense nucleic acids and coding nucleic acid sequences administered in vivo to a female, brought about by the components contained in the compositions relative to the recited intended use of increasing or decreasing fertility.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim*** withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Rejections Withdrawn

11. Claim 63 objected to because of the following informalities: for a mis-spelled word has been obviated through amendment of the claim to recite the correct spelling.